THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 93

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

PETER T. KEITH and DANIEL O. ADAMS
Junior Party[1]

v.

DONALD A. COELHO
Senior Party[2]

Interference No. 103,270

FINAL HEARING: December 18, 1996

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[1] Application 07/830,479, filed February 4, 1992. Accorded the benefit of Serial No. 07/398,756, filed August 25, 1989, abandoned. Assigned to SciMed Technology, Inc.

[2] Application 07/863,154, filed April 2, 1992. Accorded the benefit of Serial No. 07/391,419, filed August 9, 1989, abandoned. Assignor to C. R. Bard, Inc.

Before CALVERT, MARTIN and LEE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

FINAL DECISION UNDER 37 CFR § 1.658

This interference concerns a method of exchanging catheters, typically dilatation catheters used in percutaneous transluminal coronary angioplasty (PTCA). Count 2, the only count,[3] defines the subject matter in issue as follows:

> A method of exchanging a first catheter with a second catheter through a guide catheter indwelling in a living human, the first catheter having been inserted into the indwelling guide catheter over a guidewire, at least one of the first and second catheters having a guidewire lumen extending the full length thereof, the method comprising the steps of:
>
> providing a mechanism to inhibit movement of the guidewire relative to the guide catheter;
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> operating the mechanism to inhibit said relative movement; and
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> exchanging the first and second catheters, while said relative movement is inhibited by the mechanism, by
>
> withdrawing the first catheter from the indwelling guide catheter,

[3] Pursuant to motions by Keith et al. and Coelho under 37 CFR § 1.633(c)(1) (Paper Nos. 13 and 16), count 2 was substituted for original count 1.

separating the first catheter completely from the guidewire, and

then inserting the second catheter into the indwelling guide catheter over the guidewire.

Coelho Motion for Extension of Time

In part VI of their opening brief (pp. 126 to 129), Keith et al. seek review of the Administrative Patent Judge's (APJ's) order of March 18, 1994 (Paper No. 8), granting a ten-day extension of time for Coelho to file his preliminary statement. Keith et al. assert that the extension of the time for filing a preliminary statement beyond the expiration of the time for filing preliminary motions under § 1.633 was contrary to 37 CFR § 1.621(a) and beyond the APJ's authority, and that Keith et al. were prejudiced "by giving Coelho access to preliminary motions which disclose Keith et al.'s strategy in this interference" (Keith et al. opening brief, page 128 (KOB-128)).[4] They request that Coelho's preliminary statement

[4] In this decision, we will refer to the pages of the Keith et al. and Coelho records, and to their exhibits, as "KR- ," "CR- ," "JPX- " and "CX- ," respectively; to the Keith et al. opening and reply brief pages as "KOB- " and "KRB- "; and to the pages of Coelho's brief as "CB- ."

be struck, and that Coelho's proof of conception be limited to his (effective)[5] filing date (KOB-129).

37 CFR § 1.655(a)(1995) provides that at final hearing the Board may consider "whether entry of any interlocutory order was an abuse of discretion. All interlocutory orders shall be presumed to have been correct, and the burden of showing an abuse

of discretion shall be on the party attacking the order." The assertion of Keith et al. that it was "error in law" (KOB-127) for the APJ to grant Coelho's motion for extension of time is tantamount to an assertion that the APJ abused his discretion.[6]

Keith et al. argue that the provision of 37 CFR § 1.621(a) that "[w]ithin the time set for filing preliminary

[5] Each party has been accorded the benefit of the filing date of a prior application under 35 U.S.C. § 120, and neither has sought to deny the benefit accorded the opponent.

[6] As stated in the Notice of Rulemaking in which § 1.655(a) was amended, "legal error is one of the alternative bases for finding an abuse of discretion" (60 F.R. 14488, 14514 (Mar. 17, 1995), 1173 O.G. 36, 58 (Apr. 11, 1995)).

motions under § 1.633, each party may file a preliminary statement" precludes extension of the time for filing preliminary statements to a date beyond that set for filing preliminary motions. We do not agree. Although the times for filing preliminary motions and preliminary statements are normally set in the declaration notice to coincide, neither § 1.621(a) nor any other provision of the rules requires that if the latter time is extended, the former time must be. Section 1.621(a) is permissive, not mandatory, in that it merely provides that a preliminary statement may be filed during the time set for filing preliminary motions. Under § 1.645(a), "a party may file a motion (§ 1.635) seeking an extension of time to take action in an interference." We find nothing in § 1.621(a) or in any other

rule to indicate that this provision of § 1.645(a) is inapplicable to the time for filing a preliminary statement which was initially set under § 1.611(d)(1).

As noted above, Keith et al. also allege that the extension of Coelho's preliminary statement period was prejudicial to them. However, Keith et al. do not specify,

and it is not apparent to us, what that prejudice might be. Since the Keith et al. motions were, No. 1, to designate certain Coelho claims as not corresponding to the count or proposed counts (Paper No. 12), No. 2, to substitute proposed counts 1A and 1B for count 1 (Paper No. 13), and No. 3, for judgment of no interference in fact as to proposed count 1B (Paper No. 14), it is not evident how access to these motions would in any way give Coelho an advantage in preparing his preliminary statement. As Coelho states in his brief (CB-98, 99, original emphasis):

> In preparing its preliminary statement, it was in senior party's interests to allege its earliest provable dates, which necessarily could only be determined by reviewing senior party's own proofs. Junior party's preliminary motions were directed to designating senior party's cancelled claims as not corresponding to the count, substituting counts 1A and 1B for count 1, and seeking entry of judgment with respect to count 1B. Junior party has never demonstrated how the opportunity to review those motions could possibly have affected
>
> the dates alleged in senior party's preliminary statement. Indeed, it is inconceivable how junior party could have been prejudiced. Under no circumstances would it have been in senior party's

> interests to allege later dates than it could prove, and if senior party did so, no prejudice could be suffered by junior party.

Finally, it should be noted that the granting of an extension of time by way of a conference call, as in this case, was specifically sanctioned in the comments of the Notice of Rulemaking when § 1.645 was adopted (49 F.R. 48416, 48444 (Dec. 12, 1984), 1050 O.G. 385, 413 (Jan. 29, 1985)):

> § 1.610(d) authorizes an examiner-in-chief [now APJ] to hold a conference call to resolve issues and to enter an appropriate order following the conference call. A conference call may be used to obtain an extension of time. If the examiner-in-chief grants the request, an order may be entered--in which case a written motion is not necessary. The order provides the written record required by 37 CFR 1.2. . . . It should be noted that an examiner-in-chief may require a written motion notwithstanding a conference call.

Accordingly, the request of Keith et al. that we strike Coelho's preliminary statement and limit his proof of conception to his (effective) filing date is denied.

Priority of Invention

Neither party alleges in their preliminary statement either a prior actual reduction to practice or derivation.

Therefore, senior party Coelho will prevail by virtue of having the earlier effective filing date unless Keith et al. can establish conception prior to Coelho's conception, coupled with reasonable diligence during the critical period of from just prior to Coelho's conception until the filing date of the Keith et al. benefit application (their constructive reduction to practice). 35 U.S.C. § 102(g); Boyce v. Anderson, 451 F.2d 818, 820, 171 USPQ 792, 792-93 (9th Cir. 1971); Keizer v. Bradley, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959). Since the involved cases of the parties are both applications, Keith et al. have the burden of proving priority by a preponderance of the evidence. 37 CFR § 1.657(b); Oka v. Youssefyeh, 849 F.2d 581, 584, 7 USPQ2d 1169, 1172 (Fed. Cir. 1988).

The relevant dates alleged by the parties in their preliminary statements are:

	Keith et al.	Coelho
First Drawing	Oct. 3, 1988 (chalkboard) Dec. 1, 1988 (paper)	Dec. 2, 1988
First Written Description	Oct. 3, 1988 and Dec. 1, 1988	Dec. 2, 1988

First Disclosure to Others	Oct. 3, 1988	Dec. 1, 1988
Conception	Oct. 3, 1988	Dec. 1, 1988
Beginning of Diligence	Oct. 3, 1988	Dec. 1, 1988

Both parties have submitted evidentiary records. The Keith et al. record consists of the declarations of Peter T. Keith, Daniel O. Adams, Charles L. Euteneuer, Thomas R. Hektner and James L. Young, transcripts of the depositions of each of the witnesses (except Hektner) on cross-examination, and exhibits. Coelho's record consists of the declarations of Donald A. Coelho, Michael Barbere, Edward McNamara, James F. Crittenden, Terry Moore, Christine Enger and Arthur Z. Bookstein, transcripts of the cross-examination of each of these witnesses (except Enger) and of the testimony of Richelle Tartacower, and exhibits.

Coelho's Conception

Before deciding whether Keith et al. have proved prior conception and diligence, we must first determine the date of Coelho's conception.

During the time period in question, Coelho was employed by the USCI division of C.R. Bard, Inc., assignee of Coelho's
involved application, as a senior technician, then as an associate engineer. He was a member of a subgroup in the New Product Development (NPD) department, working on research and development of over-the-wire balloon angioplasty catheters (CR-11).

CX-65 and 66 are copies of two notebook pages, dated December 2, 1988, and bearing the signatures of Coelho as the

inventor and of Enger as the witness. Coelho testified that prior to this date, Enger, his immediate supervisor, told him that he was to be invited to a brainstorming session to stimulate discussion of new products that USCI might develop, and that one area USCI was interested in was a balloon angioplasty catheter which "enabled catheter exchanges to be performed with less difficulty than with prior techniques"

(CR-11). Coelho then states that prior to the meeting he conceived of a new procedure for performing a catheter exchange (CR-12):

> That procedure involved provision of a mechanism to inhibit movement of the standard length (about 170-185 cm) indwelling guidewire relative to the guide catheter and, while maintaining the guidewire in that position, first withdrawing the indwelling over-the-wire catheter, then separating it from the guidewire and, finally, threading a new catheter onto the guidewire and advancing it through the guide catheter and along the guidewire. I considered several ways of so engaging the wire, including mechanisms by which a balloon could be inflated within the guide catheter to engage and grip securely an exposed portion of the guidewire within the guide catheter.

Coelho further testified that he disclosed and explained his idea to Enger prior to the meeting (id.). Enger likewise testified at CR-157 that:

> 3. Some time before December 2, 1988, Mr. Coelho disclosed to me an idea that he had to facilitate catheter exchange of an over-the-wire angioplasty catheter without requiring the use of exchange wires, extension wires or monorail catheters. He

> disclosed to me the idea of providing a mechanism to freeze a guidewire in position within a guide catheter so that the guidewire could not move longitudinally relative to the guide catheter. He explained that with the position of the guidewire frozen, the indwelling over-the-wire catheter could be withdrawn, completely separated from the guidewire and that with the position of the wire still frozen, another over-the-wire catheter could be threaded onto the guidewire and advanced along the guidewire and through the guide catheter.

Coelho also testified that thereafter, at the brainstorming meeting he explained the method to those present, including Barbere (CR-12). Barbere, a senior project engineer in the NPD department, as well as Crittenden, the engineering manager of angioplasty development, both testified that Coelho disclosed his idea at the meeting (CR-41, 83). However, Barbere could not recall the date of the meeting (CR-42), and Coelho states in his brief that Barbere's testimony "was never intended to confirm the precise date of the brainstorming meeting" (CB-59). Crittenden testified in his declaration that the meeting was "[s]ometime before December 2, 1988" (CR-

82), but on cross-examination acknowledged that he did not recall seeing the CX-65, 66 notebook pages in December 1988, but rather based his statement as to the date of the meeting on his looking at the notebook pages when his declaration was being prepared (CR-88). We do not regard this evidence as sufficient to corroborate Coelho's testimony as to the date of the brainstorming meeting.

The first notebook page, CR-65, is titled "Rapid exchange guide wire for balloon exchange," and states at the top:

I.

> Concept: to build a guide wire with an extendable section (wire mesh or balloon) which would open and secure itself to the guide catheter. [T]his would lock in place the guide wire at the distal end of the guide catheter so that a balloon catheter may be easily exchanged.

This is followed by two drawings, showing a "hypotube" with a ring and spring arrangement, and a wire attached to the ring

and running back through the tube to the proximal end. Below the drawings is the following:

> when spring is compressed, by pulling on wire, it opens fastening itself to the Guide Catheter.

CR-66, the next notebook page, states:

II.

> The concept is to use a balloon as an anchoring device for the guide wire, to the Guide Catheter. By inflating the balloon the Guide wire is held in place within the guide
> catheter, therefor[e] allowing the dilatation
>
> catheter to be removed without an exchange wire.

There are three drawings, the first showing the distal end of a hollow guide wire with a distal spring and an inflatable balloon on the wire, and the second and third showing the proximal end of the wire with an inflation valve in the bore of the wire and a luer adapter with an "inflation hypo" and a spring. A note says that "Spring fastens luer adapter to end of Hypo for inflation." Below is stated:

> The inflation valve would seal off the inner lumen of guide wire such that the

> Luer adapter can be removed and the balloon remains inflated.

As mentioned above, these pages are signed by Enger and dated "12-2-88." Enger testified as to CX-65 and 66 (CR-158):

> 4. Exhibits 65 and 66 are copies of two notebook pages from Mr. Coelho's notebook that I read, understood and then signed and dated on December 2, 1988. It is my recollection that when Mr. Coelho showed me the notebook entries and requested me to witness them, I was already aware of his ideas as he had already disclosed them to me. Mr. Coelho had previously explained his idea for the catheter exchange procedure and had explained to me that one such mechanism used in the procedure to freeze the position of the guidewire could be in the form of a balloon within the guide catheter.
>
> 5. As part of my responsibility at USCI, I was requested from time to time to review
> and witness laboratory notebook entries of
>
> others. It was at all times, and still is, my practice to read the notebook entry to make sure that I understand it. Only then do I sign and date that laboratory notebook entry.

It is fundamental that to establish conception it must be shown by corroborated evidence that the party had possession of every feature recited in the count, and

disclosed the invention to others in such clear terms as to enable those skilled in the art to practice the invention. See Coleman v. Dines, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985). Here, Keith et al. contend that Coelho's evidence does not establish conception as of December 2, 1988, for a number of reasons.

Keith et al. first argue that CX-65 and 66 do not disclose all the method steps recited in count 2, which is clearly the case. However, there is no requirement that all limitations of a count be explicitly disclosed in a document in order to prove conception; rather, we must apply the "rule of reason" and evaluate "all pertinent evidence . . . so that a sound determination of the credibility of the inventor's story may be reached." Price v. Symsek, 988 F.2d 1187, 1195, 26 USPQ2d 1031, 1037 (Fed. Cir. 1993) (original emphasis). In the instant case, Enger testified (as quoted above) that she signed CX-65 and 66 on December 2, 1988, and that Coelho had previously explained his ideas to her. His explanation of his ideas,

which she describes at CR-157 (supra), taken with the description of the "Concept" and the apparatus shown in CX-65 and 66, is sufficient to show by corroborated evidence that as of December 2, 1988, Coelho was in possession of a conception of the method recited in count 2.

Keith et al. contend that Enger's testimony is not credible because her testimony as to when Coelho explained his ideas to her is based on the date of CX-65 and 66. This argument is not persuasive. Enger was the person who signed and dated CX-65 and 66, and testified that when she did so, Coelho had previously explained his ideas to her (CR-158). Thus, her testimony as to when Coelho explained his ideas to her is consistent with the date of the notebook pages, and there is no evidence in the record to contradict it.[7] Keith et al. also assert that Enger's statement that Coelho had explained that one mechanism to freeze the position of the guidewire "could

[7] We note that Enger was not cross-examined.

be in the form of a balloon within the guide catheter" is inconsistent
with CX-65 and 66, because the balloon shown in CX-66 is not "within a guide catheter." However, contrary to this argument,

Enger's testimony is consistent with the "Concept" paragraph at the top of CX-66, which states that the balloon would hold the guidewire in place "within the guide catheter."

A further argument by the junior party is that the apparatus shown in CX-65 and 66 would be inoperative to practice the method of count 2. Keith et al. refer to a March 22, 1989 memo from Coelho (CX-60) which states that the overall length of the rapid exchange guidewire would be 180 cm. Then, taking the lengths of various components of the system disclosed in Coelho's involved application, they calculate that when the first dilatation catheter is withdrawn sufficiently to allow the balloon on the guidewire to be inflated and anchor the guidewire, the proximal end of the dilatation catheter would extend at least 2 cm past the proximal end of the guidewire. This, according to

Keith et al., would make the proximal end of the guidewire inaccessible and prevent a physician from holding the guidewire in position and inflating the guidewire balloon (KOB-87 to 93).

We do not agree that this alleged inoperativeness vitiates CX-65 and 66 as evidence of conception. As pointed out by Coelho at CB-64 to 66, many of the dimensions employed by Keith et al. in their calculations are disclosed as approximate or typical, not rigid. Moreover, and more fundamentally, there is conception when the invention is defined in the inventor's mind such that only ordinary skill would be necessary to reduce it to practice, without extensive research or experimentation. Burroughs Wellcome Co. v. Barr Labs., Inc., 40 F.3d 1223, 1228, 32 USPQ2d 1915, 1919 (Fed. Cir. 1994), cert. denied, 515 U.S. 1130 (1995). It seems evident to us that one of ordinary skill putting into practice the method conceived by Coelho would design the lengths and positions of

the various components so that the method could be carried out. Certainly, such selection of appropriate dimensions could not be denominated as "extensive research or experimentation."

Finally, Keith et al. argue that "[b]ecause Senior Party Coelho has failed to prove conception of the method of Count 2, an ordinary skilled mechanic could not have corrected the apparatus shown in [CX] 65-66 without the exercise of inventive ingenuity" (KOB-94). However, since we have held above that Coelho has proved conception of the method of count 2, the premise on which this argument is based fails. The question is not whether one of ordinary skill would have found the method of count 2 obvious from the apparatus disclosed in CX-65 and 66, but whether, in view of Coelho's conception of the method, as corroborated by Enger, one of ordinary skill would have found it obvious to design the required apparatus (to be used in conjunction with that shown in CX-65 or 66) to such parameters as to enable the method to be carried out. This latter question we have answered in the affirmative.

In view of the foregoing, we conclude that Coelho conceived the method defined in count 2 by December 2, 1988.

Keith et al. Conception

The junior party contends that the invention of count 2 was conceived at a brainstorming session on October 3, 1988. At the time, Keith was an engineer at SCIMED Life Systems, Inc. (former assignee of the involved Keith et al. application), reporting to Euteneuer, the section manager of the cardiology department (KR-2, 40). Coinventor Adams was the director of research and development (KR-20), and Hektner was vice president of research and development (KR-54).

Euteneuer testified at KR-41, 42 that in September 1988 he was working on a project to develop a catheter system for rapid exchange. He sent out a notice (JPX-1) calling a "BRAINSTORMING SESSION FOR NON-CONVENTIONAL RAPID EXCHANGE CATHETER SYSTEMS" on October 3, 1988. The meeting was attended by, inter alia, himself, Keith and Adams.[8] At the meeting, Euteneuer states that Keith presented a method and

[8] Although Keith et al. refer to Adams as corroborating conception at this meeting (KOB-99, 106), Adams' testimony cannot serve as corroboration because he is a named coinventor. Manny v. Garlick, 135 F.2d 757, 768, 57 USPQ 377, 388 (CCPA 1943); Lasker v. Kurowski, 90 F.2d 132, 134, 33 USPQ 593, 594 (CCPA 1937).

apparatus using the "balloon on a stick" concept, i.e. (KR-42, 43):

> The "balloon on a stick" concept was essentially a captivation balloon on a fixed wire type of device. Peter Keith disclosed that during a catheter exchange a balloon dilatation catheter could be pulled back over a guidewire and into a guide catheter thereby exposing the guidewire distal of the dilatation balloon within the guide catheter lumen proximate the distal end of the guide catheter. Peter Keith then disclosed that the captivation device could be advanced down the guide catheter from the proximal end thereof, and past the dilatation balloon such that the captivation balloon was positioned adjacent the exposed portion of the guidewire, distal of the dilatation balloon but within the lumen of the guide catheter proximate the distal end of the guide catheter. Peter Keith further disclosed that the captivation balloon could then be inflated to lock, or hold the guidewire against the inner wall of the guide catheter. This would prevent the guidewire from moving proximally or distally during the remainder of the catheter exchange. Since the guidewire was immobilized, the balloon dilatation catheter could be completely withdrawn in a proximal direction from the guidewire without utilizing an extension wire. Thereafter, a different balloon dilatation catheter could be advanced over the guidewire into the guide catheter until the proximal end of the dilatation catheter extended distally of the proximal end of

> the guidewire. Thereafter, the physician could
>
> hold the guidewire in place at the proximal end while deflating the captivation balloon and removing the balloon on a stick or captivation device.

Euteneuer further testified that at the meeting Keith drew the concept on a board and they discussed various issues with the system (KR-43, 44). Also, during the meeting Euteneuer made a list of the concepts generated and discussed (JPX-2; KR-44). Item 3 on the list refers to Keith's "balloon on a stick" concept and reads "balloon along side a wire with a wire in the balloon." Euteneuer explained that (KR-45):

> The "balloon along side a wire" phrase refers to the captivation balloon being positioned along side the guidewire within the guide catheter. The "with a wire in the balloon" indicates that the over-the-wire balloon dilatation catheter is still within the guide catheter and thus having the guidewire extending therethrough.

In view of this evidence, we conclude that Keith et al. have established a conception of the invention of count 2 as of October 3, 1988. Although not supported by drawings of any apparatus to be used, the invention in issue is a method,

and most of the apparatus to be used, e.g., guide catheters, wire-
guided angioplasty balloons, etc., was already known. Even the mechanism to inhibit movement of the guidewire was made up of essentially known items, i.e., a balloon on the end of a lumen.

Therefore, we consider that Keith et al. did at that time define the invention such that only ordinary skill would be necessary to reduce it to practice. Burroughs Wellcome Co., supra. The fact that issues were discussed at the meeting about what balloon material would be desirable, etc. (KR-43, 44), and that some problems may have been subsequently encountered later, as argued by Coelho at CB-68 at seq., does not change our conclusion that the disclosure by Keith on October 3, 1988 enabled others to reduce the invention to practice "without extensive research or experimentation." Id. Also, we note that "an inventor need not know that his invention will work for conception to be complete." Id.

Keith et al. Diligence

In order to prevail, Keith et al., the prior conceiver, must also prove reasonable diligence during the critical period, which extends from just prior to Coelho's conception date of December 2, 1988, to the effective filing date of Keith et al. on August 25, 1989. The testimony corroborating diligence must be specific as to dates and facts. Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949).

We must first determine whether Keith et al. were diligent from a time "just prior," "immediately prior" or "just before" December 2, 1988. Gould v. Schwalow, 363 F.2d 908, 911, 150 USPQ 634, 637 (CCPA 1966); Scharmann v. Kassel, 179 F.2d 991, 996, 84 USPQ 472, 476 (CCPA 1950).

Euteneuer[9] testified that, following the brainstorming session on October 3, 1988:

[9] We refer to the testimony of Euteneuer because, except for item (3), he is the only non-inventor (i.e., corroborating) witness to testify as to these events.

(1) There was a follow-up brainstorming meeting on October 13, 1988 (KR-46);

(2) Between October 3 and 20, 1988, Adams disclosed to him an embodiment of the invention in which the captivation balloon was fixed in the distal end of the guide catheter (KR-46);

(3) He prepared, on October 20, 1988, a list of the concepts discussed at the October 3 and 13 meetings (JPX-5), on which item 23 documents the concept of the present invention (KR-46, 47);

(4) "On or before December 1, 1988, I recall a discussion with
Dan Adams and Peter Keith regarding obtaining patent protection
for Peter Keith's wire captivation concept. . . . Both Dan Adams and myself directed Peter Keith to prepare a disclosure of the wire captivation concept for our patent attorneys." (KR-47);

(5) On December 1, 1988, Keith prepared a drawing (JPX-7) and description (JPX-8) of the wire captivation concept (KR-47).

With regard to these events, items (1) to (3) clearly are not activities which were "just prior" to December 2, 1988, since they all occurred on or before October 20, 1988, some six weeks beforehand. See, e.g., Scharmann, 179 F.2d at 996, 84 USPQ at 477, where activity approximately a month prior to the date the opponent entered the field was held not to be "immediately prior to" that date and hence "not relevant on the question of appellant's diligence."

As for the discussion listed as item (4), the record does not establish that it specifically took place "just prior" to December 2, but only that it occurred "[o]n or before December 1, 1988" (KR-47). This broad statement would be inclusive of any date from December 1 back to October 20, or even earlier.

Accordingly, whether Keith et al. were diligent from "just prior" to December 2 depends upon whether they have shown by corroborated evidence that the drawing (JPX-7) and description
(JPX-8) were being prepared or completed on December 1, 1988. We do not consider that they have. Although both documents

are dated "12/1/88," they are not signed by anyone. Euteneuer, who purports to corroborate them, states in his declaration that (KR-48, emphasis added):

> I recall discussing the drawing included as Exhibit 7 and the description shown in Exhibit 8 with Peter Keith on December 1, 1988, or a few days thereafter. Exhibits 7-8 are true and accurate copies of the original drawing and description I discussed with Peter Keith on December 1, 1988, or a few days thereafter.

In addition, on cross-examination he testified at KR-532, 533 that he did not see Keith draw JPX-7, but he did see it "shortly after it was completed," "[d]ays at the most." Euteneuer testified as to JPX-8 that he did not see Keith prepare it, but read it when he discussed it with Keith, which could have been a week later than December 1 (KR-533, 534). This testimony by Euteneuer does not corroborate that JPX-7 and 8 were prepared on December 1, but only that they were in existence a few days (or as much as a week) thereafter. However, a few days after December 1 is also subsequent to Coelho's conception on December 2. Therefore, Keith et al.

cannot prevail because they have failed to prove, by corroborated evidence, the exercise of diligence from "just prior" to Coelho's conception date.

Conclusion

In summary, we conclude that:

(1) Coelho conceived the invention of count 2 as of December 2, 1988;

(2) Keith et al. conceived the invention of count 2 as of October 3, 1988;

(3) Keith et al. did not exercise reasonable diligence from just prior to December 2, 1988.

Judgment

In view of the foregoing, Peter A. Keith and Daniel O. Adams, the junior party, are not entitled to a patent containing claims 26, 27, 51, 52 and 60 of their involved application, designated as corresponding to the count. Donald A. Coelho, the senior party, is entitled to a patent containing claims 38, 40, 55 and 57 of his involved application, designated as corresponding to the count.

IAN A. CALVERT)
Administrative Patent Judge)
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) BOARD OF PATENT
JOHN C. MARTIN) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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)
)
JAMESON LEE)
Administrative Patent Judge)

psb

Interference No. 103,270

Attorney for Keith et al.:

David M. Crompton
Nawrocki, Rooney & Sivertson, P.A.
Suite 401
Broadway Place East
3433 Broadway Street, N.E.
Minneapolis, MN 55413

Attorney for Coelho:

Arthur Z. Bookstein
Bookstein & Kudirka, P.C.
One Beacon Street
Boston, MA 02108